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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEREIDA MARIA MENENDEZ, PAULA S. WILLIAMS, and MICHAEL J. MANIS

Appeal 2007-3067
Application 09/698,502
Technology Center 3600

Decided: February 20, 2008

Before WILLIAM F. PATE, III, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Nereida Maria Menendez, Paula S. Williams, and Michael J. Manis (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-18, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a way for completing and storing an electronic rental agreement for an item or service, such as a vehicle rental service (Specification 1:15-17).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

> 1. A method for completing and storing an electronic rental agreement, said method comprising the steps of:
>
> [1] entering
>
> reservation-related information and
>
> rental-related information
>
> for an item or service,
>
> said entering step entering:
>
> (a) said rental-related information without employing a master rental agreement, or
>
> (b) at least some of said rental-related information from a master rental agreement and allowing modification of said information from the master rental agreement for rental of said item or service without modifying the master rental agreement;
>
> [2] providing a reservation for said item or service based at least in part upon said reservation-related information;
>
> [3] creating and displaying a rental proposal based upon said reservation and said rental-related information;
>
> [4] electronically accepting said rental proposal; and

[5] storing the electronic rental agreement based upon said accepted rental proposal.

This appeal arises from the Examiner's Final Rejection, mailed May 11, 2004. The Appellants filed an Appeal Brief in support of the appeal on February 7, 2005. An Examiner's Answer to the Appeal Brief was mailed on March 7, 2007. A Reply Brief was filed on November 9, 2005.

PRIOR ART

The Examiner relies upon the following prior art:

Coutts US 5,389,773 Feb. 14, 1995

Information on Hertz Corporation, archived web pages printed through www.archive.org (1997-2000),

Avis Rent A Car – Rates and Reservations, http://www.avis.com/rates_and_reservations/ (last visited March 03, 2000).

Dollar Rent A Car Introduces "DOLLAR(R) TRAVEL CENTER" at Key Airport Locations, Customers Obtain Free Travel Information At Interactive Kiosks, http://www.kioskcom.com/articles_txtdetail.php?ident=115 (last visited May 14, 2000)(hereinafter Kioskcom).

REJECTIONS

Claims 1-5, 10-12, 14-16, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.

Claims 13 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Kioskcom.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Kioskcom.

The pertinent issues turn on whether the art describes a rental agreement.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Claim Construction

01. The disclosure contains no lexicographic definition of "agreement."

02. The ordinary and customary meaning of "agreement" is (1) the act of agreeing; (2) harmony of opinion; accord; (3) an arrangement between parties regarding a course of action; a covenant; (4) Law (a) a properly executed and legally binding

contract; or (b) the writing or document embodying this contract.[1] These definitions are substantially the same as those provided by the Appellants in the Evidence Appendix to the Appeal Brief.

03. The disclosure contains no lexicographic definition of a master agreement.

04. The usual and customary meaning of "master" as an adjective is (1) to act as or be the master; (2) principal or predominant; (3) controlling all other parts of a mechanism; (4) highly skilled or proficient; or (5) being an original from which copies are made.[1]

Admissions

05. The Appellants admit that Hertz describes accepting a reservation proposal and storing an electronic reservation agreement (Appeal Br. 5:Second ¶).

Hertz

06. Hertz is a web site for Hertz, the car rental company, which provides the contents of the legal requirements for its agreements and provides screens for customers to enter rental reservations.

07. Hertz describes its system as allowing a customer to make, modify, or cancel a reservation (Hertz 27).

08. Hertz describes the use of a customer profile for entering data into a reservation (Hertz 17).

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[1] *American Heritage Dictionary of the English Language* (4th ed. 2000).

09. Hertz portrays radio button selection of entry by customers with existing profiles and general customers (Hertz 36).

10. Hertz describes an offer for a rental vehicle for value containing the material terms of the agreement, and requesting acceptance by the customer (Hertz 44).

Avis

11. Avis describes entry and storage of a vehicle rental reservation.

Kioskcom

12. Kioskcom describes using kiosks by Dollar Rent-A-Car.

Coutts

13. Coutts is directed to a self-service system arranged to store data relating to previous transactions initiated by various users of the system, and arranged to predict the type of transaction to be initiated by a given user, the mode of operation of said system when performing a transaction for a particular user being dependent on a prediction made by said prediction means following identification of that user (Coutts 1:36-51).

14. Coutts describes its contents as applicable to self service systems, of which ATM's are examples (Coutts 1: 7-20).

Knowledge in the art

15. One of ordinary skill knew that a Boolean data element to signify the presence or absence of an item was known as a *flag*.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

Automation of a Known Process

It is generally obvious to automate a known manual procedure or mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have found it obvious to combine an old electromechanical device with electronic circuitry

> to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. . . . The combination is thus the adaptation of an old idea or invention . . . using newer technology that is commonly available and understood in the art.

Id at 1163.

Obviousness and Nonfunctional Descriptive Material

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

ANALYSIS

Claims 1-5, 10-12, 14-16, and 18 rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.

Claims 1-5, 10, 11, and 14-17

The Appellants argue claims 1-5, 10, 11, and 14-17 as a group.

Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Hertz described all of the limitations of claim 1 except for storing the agreement. The Examiner further found that (1) it was known to those of ordinary skill that rental agreements as in Hertz were stored for retrieval; (2) Avis described storing a rental agreement; and (3) that one of ordinary skill would have known that Hertz and Avis were describing similar products. The Examiner concluded it would have been obvious to a person of ordinary skill in the art to have applied Avis' storage of a rental agreement to Hertz because of the commonality of contents between Hertz and Avis (Answer 4-5).

The Appellants contend that Neither Hertz nor Avis describe an electronic rental agreement, and therefore do not describe or suggest limitation [5] of claim 1 (Appeal Br. 5:Second ¶). The Appellants argue that an agreement is a contract (Appeal Br. 5:First ¶), and there is no meeting of minds in Hertz as to price and optional items, which the Appellants characterize as essential terms of a rental contract. The Appellants cite several court opinions for the proposition that failure to agree on essential terms negates a contract. The Appellants also contend that Hertz fails to describe element [1a] of claim 1.

We disagree. Initially, we find that the Appellants admit that Hertz stores an electronic reservation agreement (FF 05). We next must construe the term "electronic rental agreement" in limitation [5] of claim 1. This term

is not defined lexicographically by the disclosure (FF 03). The noun "agreement" has several definitions.

While one of those definitions, within a legal context, is narrowly drawn to a contract, as argued by the Appellants, a broader definition, still within the ambit of the claimed subject matter, is an arrangement between parties regarding a course of action, or even simply an accord (FF 04). Since limitations are construed as broadly as reasonable during examination, we construe an agreement to be an accord.

Thus an electronic rental agreement is an accord as to a rental entered by electronic means. Thus, the electronic reservation for a vehicle rental agreement described by Hertz, as admitted by the Appellants, is an accord as to a rental entered by electronic means.

Even absent such an admission, we find that Hertz describes a screen offering a vehicle rental for value, including all of the material terms, and requesting acceptance (FF 10). The request for acceptance implies the subsequent act of acceptance, which would create a contract. Whether such a contract were contingent on certain performance, such as picking up the vehicle, would not diminish the character of the agreement as a contract, and certainly not as an agreement as to the terms contained therein. Finally, even were a court to find that a specific instance of an agreement in Hertz were not a contract, we find there would be no patentable distinction between such an agreement by Hertz and a contract as such, because any such distinction would be predicated entirely upon the nonfunctional descriptive contents of the agreement. *See Ngai*, 367 F.3d at 1339.

As to the argument that Hertz fails to describe limitation [1a], we find that this is an alternative limitation. The Appellants do not contend that Hertz fails to describe limitation [1b], the remaining alternative limitation, and we find that Hertz does describe entering some information from a customer profile (FF 08) and editing that information (FF 07).

Claim 4

Claim 4 further requires entering at least some of said rental-related information from a master rental agreement; and allowing modification of information from the master rental agreement for rental without modifying the master rental agreement.

The Examiner found that Hertz described entering some information from a customer profile and that information could be modified in the resulting rental agreement (Answer 5).

The Appellants contend that Hertz fails to describe modifying some information from a master agreement without modifying the master agreement (Appeal Br. 10:Last full ¶).

We disagree. First, we must construe the limitation of a master rental agreement. This limitation is not lexicographically defined by the disclosure (FF 03). The broadest usual and customary meaning of "master" as an adjective within the context of loading data into an agreement is being an original from which copies are made (FF 04). We therefore construe a master rental agreement to be a rental agreement from which copies are made.

We find that Hertz describes storing customer agreement preferences in a profile (FF 08). We further find that Hertz describes the remaining

portions of what their agreements contain within the pages of their web site (FF 01). Therefore, we find that the customer profiles, combined with the non-discretionary portions of Hertz's rental contract, together form a rental agreement from which copies are made. We next find that after using the data from a customer profile to create an agreement, that data may be modified (FF 07). Such editing does not rely upon the customer profile, and certainly does not result in altering the customer profile data.

We conclude that Hertz does describe modifying some information from a master agreement without modifying the master agreement.

Claim 12

Claim 12 further requires storing a flag along with the unique transaction in the database system to indicate that the accepted rental proposal is electronically signed.

The Examiner found that Hertz accepts an indication of acceptance, which is inherently stored by Hertz, and that such a data element indicating acceptance is an example of a flag (Answer 6).

The Appellants contend that Hertz describes only reserving a vehicle and therefore does not contain an electronic signature of acceptance (Appeal Br. 11-12).

We disagree. Hertz explicitly requests a click to accept a reservation (FF 10). Since such clicking to accept is electronically created evidence of acceptance, it forms an electronic signing. One of ordinary skill knew that the data element indicating whether such click had occurred was referred to by the term of art, flag (FF 15).

Claim 18

Claim 18 further requires completing and storing the electronic rental agreement based upon the accepted rental proposal without completing a handwritten rental agreement.

The Examiner found that Hertz describes entering an agreement electronically rather than in hand writing (Answer 7-8).

The Appellants repeat their argument in support of the patentability of claim 1. We find this argument unpersuasive here for the same reasons we found as to claim 1, *supra*.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.

Claims 6-9 rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.

The Appellants argue claims as a group.

Accordingly, we select claim 6 as representative of the group.

Claim 6 further requires maintaining a history of rental information for prior rentals by a user; entering information from an identification of a user; and entering at least some of rental-related information from the history based upon information from an identification of a user without employing a master rental agreement.

The Examiner found that Coutts describes entering information from transaction history and that one of ordinary skill would know the benefits of using historical transaction data to assist in completing a form. The

Examiner concluded it would have been obvious to a person of ordinary skill in the art to have applied Coutts' data entry from history to the form completion in Hertz to assist in completing Hertz's form (Answer 8).

The Appellants contend that Coutts is directed to banking machines and therefore is non-analogous art (Appeal Br. 15-16).

We disagree. Coutts is directed to self service systems generally (FF 14). Kiosks such as those used for car rentals would be species of the genus of self service systems to which Coutts applies. Coutts describes the advantages of using transaction history in filling forms with such kiosks (FF 13).

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 127 S.Ct. at 1740.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.

Claims 13 and 17 rejected under 35 U.S.C. § 103(a) as unpatentable over Herz, Avis, and Kiosk.com.

The Appellants relied on their arguments in support of claims 1 and 12, which we found did not overcome the Appellants' burden of showing

error, and therefore the Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Herz, Avis, and Kioskcom.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-18 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

On this record, the Appellants are not entitled to a patent containing claims 1-18.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis is sustained.
- The rejection of claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts is sustained.
- The rejection of claims 13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Herz, Avis, and Kioskcom is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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